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3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/972,403	ALBAZZ ET AL.
	Examiner	Art Unit	
	HEIDI RIVIERE	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _11/17/2009_.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _9-11,13-19,21-24,33-35 and 37-40_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _9-11,13-19,21-24,33-35 and 37-40_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed **11/17/2009** have been fully considered but they are not persuasive.

2.   In regards to the 35 USC 101 rejection of claims **9-11 and 13-16**: Applicant argues that the 35 USC 101 rejection should be withdrawn because the "communicating of a user interface requires the use of a machine since not all machines are capable of communicating user interfaces." (Page 12 Arguments) First of all, since "not all machines are capable of communicating user interfaces" it is dependent of Applicant to clearly state within the claims whether a machine is used and if so which. In claim 9, for example, step (a.) is unclear because it seems consists of the positively claimed sub-steps of storing, receiving and referencing. The generation of a user interface is never claimed as it is noted that the generation of this interface is merely referenced once the information is received. It is also unclear whether the step of storing is a first step or second step. As a result, when the user interface is communicated to a contracting party in step (b.) the communicating is interpreted as not being performed by a machine.

3.   Furthermore, there is no subject matter transformation in regards to these limitations. Stored data is merely the same subject matter stored. Generated data is merely the same subject matter generated. And interlocked data is merely the same data interlocked. The data or information is not altered or changed. The rejection of

claims 1-8 and 25-32 are now moot as these claims have been canceled. Therefore the 35 USC 101 has not been withdrawn.

4.   The Double patenting rejection is not withdrawn. Applicant's argument in regards to the product list filters remains unclear as the claims discussed are never noted.

5.   The 35 USC 112 paragraph 2 rejection of the pending claims is not withdrawn. Applicant's argument that "communicating a user interface" is not vague and specific by noting "if Examiner went onto the Internet and entered a website having a particular interface, prior to the Examiner 'entering the website,' a user interface would have been communicated" remains vague. Please note the discussion in paragraph 2 above. As a result, the rejection is not withdrawn.

6.   The 35 USC 103 (a) rejection of the pending claims is not withdrawn. Applicant focuses arguments on the Conklin reference. Applicant argues that Conklin does not teach the compilation of business rules or at least one terms and conditions. However, Conklin in Fig. 16 shows that the terms selections are presented via an Internet interface and furthermore the selection of terms and conditions are presented in Figs. 1h; 1I; 11a-1 and 11a-2. As a result, the rejections are not withdrawn.

Double Patenting

7.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ

644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

8.   **Claims 9-11, 13-19, 21-24, 33-35, 37-40** are provisionally rejected on the ground

of nonstatutory obviousness-type double patenting as being unpatentable over **claims**

9-14, 16, 21-24 and 33-35 of copending **Application No. 09/827,431**; **claims 1-3, 5-8,**

10-13, and 15-18 of copending **Application No. 09/972,434**. Although the conflicting

claims are not identical, they are not patentably distinct from each other because all

three applications claims systems for generating a contract involving storing business rules and terms and conditions, generating links between the rules and terms and conditions as well as interlocking the business rules, terms and conditions and the links to lock the contract. They all have a plurality of tiers, product list filters, elements that can be unilaterally filtered and product list filters.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections. 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   **Claims 9-11 and 13-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.   **With regards to claims 9-11 and 13-16** the claims as written are confusing. For example claim 9 states "communicating a user interface".   How is an interface communicated? And the limitation taken as a whole reads "communicating a user interface to a contracting party, wherein the contract is generated by".   Did Applicant mean to confer that instead of contract the "contracting party" is generated? Or instead of contract the "user interface" is generated?

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1.   **Claims 9-11 and 13-16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4.   **With regards to Claims 9-11 and 13-16:** In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials). *In re Bilski*, 545 F. 3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 9-16, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

An example of a method claim that would <u>not</u> qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the machine that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the Bilski decision since they are not tied to another statutory class and can be preformed without the use of a

particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed

within the human mind.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 9-11, 13-19, 21-24, 33-35 and 37-40** are rejected under 35 U.S.C. 103(a)

as being unpatentable over **Conklin et al. (U.S. 6,338,050)** (Hereinafter referred to as

Conklin) in view of **Shirley et al. (US 5/692,206)** (hereinafter "**Shirley**") .

1.   With respect to **Claims 9, 17, and 33:**

Conklin discloses:

storing the contract terms and conditions (Conklin: col. 21 – relational

structuring of database; Figs. 1h; 1I; 11a-1 and 11a-2 – terms to be entered in

the contract are chosen; col.23 – storing of negotiations and results data;

detailed rules for ordering),

receiving information (Conklin; Col. 23, lines 15-67 – desktop computer

and Internet used), and

communicating a user interface to a contracting wherein the user interface

displays selected information based on terms and conditions in the contract

(Conklin; Figs. 1h; 1I; 11a-1 and 11a-2 – terms to be entered in the contract are

chosen via Internet presentation, Col. 23, lines 15-67 – desktop computer and

Internet used; Fig. 16 - types of terms chosen)

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of

rules available to be selected for inclusion in the contract, storing at least one

terms and conditions set containing parameters corresponding to selected rules

from the compilation of business rules, generating links between the compilation

of business rules and the terms and conditions set to generate specific terms and

conditions to be embodied in the contract. (Conklin: Fig. 1j – rules built based on

community; col. 21 – relational structuring of database; col.23 – storing of

negotiations and results data; detailed rules for ordering);

and interlocking the compilation of business rules, the terms and

conditions set and the links to lock the contract (Conklin: Fig. 1j – rules built

based on community; cols. 19 and 21 and col. 22, lines 1-40 – authoring process

integrated with databases; relational structuring of databases; "databases 225

created according to the present invention use a combination of record, filed,

relational names and delimiters to interrelate the elements within; Data is kept

secure with firewalls and SSL encryptions; col. 20, lines 45-65 – "the present

invention protects the documents with separate user names, passwords and

access levels for each inquirer"; col. 21, "Unique id's feature is used to insure the

proper data is found and transmitted. That is, the present invention associates

unique identifiers (id's) with each sponsor, participant, and type of data or

transaction.   Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; col. 24, lines 15-60 - final document is noted as complete);

Conklin does not teach, however Shirley teaches referencing the terms and conditions of the contract to process the information and generate user interfaces in response (Shirley: Figs. 11a and 11b; col. 6, lines 20-60; col. 8-col. 9, line 30 – provisions are selected by authoring unit and used by user to complete document and use in Microsoft Word)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Conkling and Shirley. Both references discuss the steps involve with the generation of a contract. The references of the terms and conditions of a contract are necessary for future interpretation in case of a dispute.

2.   With respect to **Claims 11, 19 and 35:**

Conklin discloses in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list (Conklin col. 19, lines 57-60, "Buyer processes shown in FIG. 1g include search and evaluate processes, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings."; col. 20, lines 1-50 – catalog and price list; web server software used).

The data in which the contract contains is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data in which the contract contains adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data in which the contract contains does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

3.   With respect to **Claims 13, 21, 37:**

Conklin discloses storing at least one product list filter for generating a list of a specified subset of products from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products (Conklin col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; relational names and delimiters to interrelate the elements within).

The data in which the product list is non-functional descriptive data.

4.   With respect to **Claims 14, 22 and 38:**

Conklin discloses the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products (Conklin Fig 1g, item 70, "Search & Evaluate").

The data in which the product list is non-functional descriptive data.

5.   With respect to **Claims 15, 23 and 39:**

Conklin discloses the contract comprises dynamic elements which can be unilaterally altered by a contracting party (Conklin col. 23, lines 37-53, "participant proposing terms to another participant on an initiating terminal (or desktop computer or workstation, etc.) over the Internet through multivariate negotiations engine system, thereby creating a communications path which is ultimately directed by multivariate negotiations engine system over the Internet to the destination terminal at which the selected other participant is active.").

The data in which the contract contains is non-functional descriptive data.

6.   With respect to **Claims 16 and 40:**

Conklin discloses the product list filter is a dynamic element (Conklin col. 14, lines 1-29, "...allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms...").

The data in which the product list is non-functional descriptive data.

7.   With respect to **Claims 10, 18, and 35:**

Conklin discloses the user interface displays selected information based on terms and conditions in the contract (Conklin col. 14, lines 1-29, "...allows a

buyer/participant to search and evaluate seller information, propose and negotiate

orders and counteroffers that include all desired terms…").

CONCLUSION

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831.

The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. R./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689